

REMARKS

Claims 1-3, 10, 20, 22, 24-25, 27, 29-30, 44, 46-47, 49, 51-52, and 61-62 are pending in the application.

Claim 10 has been amended to delete -CS- as a potential group for substituent Y. Claim 10 has further been amended to correct the spelling of alkoxy.

No new matter is added. Entry is respectfully requested.

I. Preliminary Matters/Restriction Requirement and Election of Species

On page 2 of the Office Action, the Examiner acknowledges Applicants' species election of 4-(2-ethylbutyl)-N-(3-fluoro-5-(trifluoromethyl)phenyl)-4-hydroxy-1-piperidinecarboxamide, without traverse.

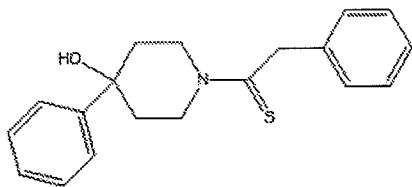
In addition, the Examiner acknowledges Applicants' comment in the December 1, 2009 Amendment that the Examiner's drawing actually depicts 4-(2-ethylbutyl)-N-(5-fluoro-3-(trifluoromethyl)phenyl)-4-hydroxy-1-piperidinecarboxamide. In response (in the present Action), the Examiner contends that Applicants' species compound could be named either way (5-fluoro-3 or 3-fluoro-5) and requests that Applicants submit a drawing of the correct compound.

In response to the Examiner's request, Applicants confirm that the species can be named either 4-(2-ethylbutyl)-N-(3-fluoro-5-(trifluoromethyl)phenyl)-4-hydroxy-1-piperidinecarboxamide *or* 4-(2-ethylbutyl)-N-(5-fluoro-3-(trifluoromethyl)phenyl)-4-hydroxy-1-piperidinecarboxamide.

II. Response to the Claim Objections

At Paragraph 5 of the Action, the Examiner indicates that the claim amendments filed on December 1, 2009 have overcome the above rejection over Ashwell et al.

Thus, examination was again expanded under Markush practice to the following compound, shown at page 5, Paragraph 3 of the Office Action:



wherein R¹ is a substituent (i.e., phenyl (see Specification Page 16 for a definition of "substituent" of ring A), R² is hydroxyl; R³ is absent (i.e. r is 0); X is a single bond; Y is -CS-; Z is -NH-; and B is phenyl. The Examiner alleges that this species reads on claims 10, 20, and 44, which are rejected under 102(b) to Agrawal et al (Indian Journal of Pharmacy 39(6):139-140, 1977)("Agrawal"), leaving claims 22, 24-25, 27, 29-30, 46-47, 49, and 51-52 objected to as depending from a rejected base claim.

In view of the amendment to claim 10, Applicants submit that the rejections over Agrawal have been overcome and thus, the objections to the claims are rendered moot.

At page 4, Paragraph 7 of the Action, the Examiner objects to claim 10 for misspelling "alkoxy" regarding substituents R² and Z.

In response, Applicants have amended claim 10 to correct the spelling of alkoxy.

Withdrawal of the objections to the claims is respectfully requested.

III. Response to Rejection of the Claims under 35 U.S.C. § 102(b)

At pages 4-5 of the Office Action, the Examiner rejects claims 10-11 and 44 as allegedly being anticipated by Agrawal as evidenced by the STN Search Report (Accession Number 1978:130817).

The Examiner asserts that Agrawal discloses a compound at CAS RN 65846-22-2 that reads on the compound of present claim 10.

Preliminarily, Applicants note that the Office Action incorrectly indicates that claim 11 is rejected. Applicants request that the Examiner correct the record by correctly identifying the rejected claims.

In response and without acquiescing to the merits of the rejection, Applicants have amended the compound of present claim 10 by deleting -CS- as a potential group for substituent Y.

In the Agrawal compound, R¹ is phenyl, R² is a hydroxyl, R³ is absent (because r is 0), X is a single bond, Y is -CS-, Z is -NH-, and B is phenyl. None of the compounds disclosed in Agrawal teaches or suggests a compound wherein Y is -CO-, as is presently required in claim 10. Thus, Agrawal cannot be said to anticipate the present claims.

Withdrawal of the rejection over Agrawal is respectfully requested.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
Application No.: 10/519,113

Attorney Docket No.: Q85522

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

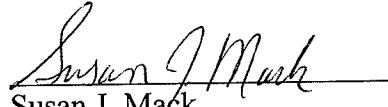
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